



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In Re Application of:)

LUFFEL, Robert, W., *et al.*)

Serial No. 09/371,708)

Filing Date: August 9, 1999)

For: LATERALLY EXPANDABLE)
MODULAR DATA STORAGE SYSTEM)

Examiner: Davis, D.

Group Art Unit: 2652

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APPELLANTS' REPLY BRIEF

To: The Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

This Reply Brief is submitted in response to the Examiner's Answer, paper
number 17, dated July 2, 2003.

RESPONSE TO EXAMINER'S ANSWER

Procedural Issues:

The examiner confirmed that the appellants' brief includes a statement that claims 1, 3-7, 12-19 and 24 do not stand or fall together and that the appellants' brief meets the requirements of 37 C.F.R. § 1.192(c)(7) and (c)(8).

Patentability Issues:

Introduction

This entire appeal could have been avoided had the examiner entered appellants' amendments that directly traversed his rejections during prosecution. The examiner took the same position during prosecution that he takes here: "Appellants have not claimed a "one-piece" guide member and gear rack arrangement. Appellants claim an "integral" guide member and gear rack." Answer at p. 4. Appellants argued during prosecution and in this appeal that "integral" means formed from a single unit, or one-piece. Despite the appellants' explanation during prosecution that the claim term "integral" means formed from a single unit, the examiner continued to insist that integral meant something else without regard to the contrary language in the specification. To clear up any confusion, after receiving the final office action, the appellants sought to amend their claims "to more clearly define the limitation that the guide member and gear rack are both formed from a single unit (in other words, 'integral')." The amendments traversed the examiner's rejection. Had the examiner entered the amendments, his basis for an anticipation rejection over Tadokoro would have evaporated since Tadokoro discloses a two-member guide rail as opposed to one formed from a single unit.

Despite that fact, the examiner refused to enter the amendment for two stated reasons: (1) the amendment raised new matter and (2) the amendment would not materially simplify the issues for appeal. Those stated “bases” are without foundations. First, there is no new matter because the appellants’ arguments during prosecution centered on the meaning of the word “integral” and the fact that it means one piece, or formed from a single unit, with language from the specification to support that. Therefore the relevant prior art and arguments related to it were already raised during prosecution. Second, the examiner’s own arguments demonstrate that entering the amendments would have materially simplified the issues on appeal. The majority of the issues in dispute in this appeal relate to the construction of the term “integral” and whether it means one piece or more than one piece. Had the examiner entered the amendment that the appellants submitted after his final office action, construction of the word “integral” would no longer even be an issue in this appeal. There simply was no basis under 37 C.F.R. §1.121 to refuse to enter the amendment. *See* MPEP 714.22.

Response to Examiner’s Arguments

Section 11 of the Examiner’s Answer sets forth the examiner’s response to the arguments made by the appellants in the Appeal Brief. Appellants reply to the examiner’s responses in the order presented in the Examiner’s Answer.

On pages 4 and 5 of the Answer, the examiner maintains that the term “integral” as used in the claims is not restricted to a one-piece article. The examiner cites several CCPA cases and even to Webster’s dictionary in an effort to support his conclusion. The examiner’s arguments are contrary to the law of claim construction.

The Court of Appeals for the Federal Circuit has ruled that the inventor's definition and explanation of the meaning of a word, as evidenced by the specification, controls the interpretation of that claim term, even over a dictionary definition. *See Serrano v. Telular Corp.*, 111 F.3d 1578, 42 USPQ2d 1538 (Fed. Cir. 1997). In that case, the Federal Circuit rejected the alleged infringer's claim construction based on a dictionary definition because "Serrano's proposed dictionary definition thus is inconsistent with the specification." *Serrano, supra*, at 1582. Rather, the Federal Circuit held, "[t]he inventors' definition and explanation of the meaning of the [claim term at issue] . . . , as evidenced by the specification, controls the interpretation of that claim term. *See Vitronics Corp. v. Conceptronic, Inc.*, 90 F3d 1576, 1582, 30 USPQ2d 1573, 1576-77 Fed. Cir. 1996) (stating that a patentee may choose his or her own definition for claim terms, if that definition is clear from the patent or file history)." *Serrano, supra* at 1582. The term "integral," as used in the currently-pending claims means that the guide member is formed from the same member as the gear rack. This arrangement is shown in the drawings and is discussed at length in the specification. *See*, for example, page 23 of appellants' Appeal Brief. The examiner's re-definition of the term "integral" to mean something other than the meaning assigned to it by the inventor is contrary to *Serrano* and *Vitronics, supra*, and thus cannot be used to support the examiner's rejections.

Even if it were proper to turn to judicial rulings (or a dictionary) for a definition of the term "integral," which it is not (where, as here, the specification clearly provides the basis for the meaning of the term), appellants refers the Board to *Mahurkar v. Arrow Int'l, Inc.*, 160 F. Supp. 2d 927 (N.D. Ill. 2001), where the court found that: "[i]ntegral means one-piece formation, as opposed to bonded, which is a two-piece construction."

See Mahurkar, supra, at 943. Significantly, the court reached this conclusion after applying the test set forth in *Serrano, supra*. That is, the court found that “[t]he patent, the prosecution history and the common usage of the terms all suggest “integral” means being formed from one piece of material. . .” *Mahurkar, supra*, at 943.

Anticipation requires strict identity. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 90 (Fed. Cir. 1986). All of the elements of the claimed invention must be literally present in the prior art reference as arranged in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Similarity of elements is not enough. The Tadokoro reference does not meet this standard when examined in light of the currently-pending claims. Because each of the claims at issue requires at least a guide member that is integral with a gear rack, the term integral meaning formed from a single piece, and because Tadokoro discloses separate gear racks 32 and guide members 8, Tadokoro cannot anticipate any of the currently-pending claims as a matter of law.

Turning now to the examiner’s reasons for rejecting dependent claim 3, the examiner argues that the wheel disclosed in Tadokoro is the same as the sliding bearing arrangement described by claim 3. More specifically, claim 3 requires that the first elongate guide member comprise “first and second opposed bearing surfaces. . . wherein said first bearing mounted to the cartridge access device slidably engages the first and second opposed bearing surfaces. . .” In Tadokoro, the vertical guide member is guided along the guide member 8 by wheels 33. Therefore, the examiner’s argument is erroneous on its face because a wheel is not a bearing that “slidably engages.” Thus, Tadokoro cannot anticipate claim 3.

Perhaps in an attempt to buttress his position, the examiner cites to the dictionary meaning of the term “slide” in a strained effort to say that a wheel moves “over a surface while maintaining smooth, continuous contact.” This argument fails on two grounds. First, a rolling wheel does not maintain “continuous contact” with a surface. Rather, a new portion of the outer periphery of the wheel is brought into contact with the surface as the wheel rolls. Stated another way, no single point on the outer periphery of a wheel maintains “continuous contact” with the surface (unless the wheel is skidding without rolling). Any given point on the outer periphery of the wheel only contacts the surface once for each revolution of the wheel, which represents a distance along the surface of π multiplied by the diameter of the wheel. Clearly, any given point on the outer periphery of a wheel does not make “continuous contact” with the surface.

The second ground on which the examiner’s argument fails is that for a wheel to make “continuous contact” with the surface, as required by the examiner’s definition of “slide,” requires that the wheel skid along the surface without rolling. However, the intended use of a wheel (including Tadokoro’s wheel 33) is that it roll, not skid. By arguing that Tadokoro’s wheel 33 meets the dictionary definition of “slide,” the examiner requires Tadokoro’s wheel 33 to be non-functional for its intended purpose. This cannot serve as a basis for rejecting claim 3 under Section 102.

The examiner’s arguments, if affirmed by the Board, would thus lead to the absurd conclusion that a wheel is really a bearing that “slidably engages,” or that Tadokoro’s wheel be regarded as non-functional for its intended use, i.e., that it always skid over the surface and never roll. Neither conclusion can be used to support an anticipation rejection.

The next argument made by the examiner relates to claim 6. First, the examiner argues that claim 6 does not “require guidance.” That is not the case. Claim 6 recites the translation apparatus as defined by claim 5, further comprising a “third bearing mounted to the cartridge access device, said third bearing contacting said first elongate gear rack.” The effect of the third bearing in contacting the first elongate gear rack is to guide the cartridge access device along the displacement path. Perhaps concluding that the Board would not be persuaded by this argument, the examiner goes on to state that even if claim 6 requires guidance, Tadokoro’s gear is really a bearing, thus anticipating claim 6. Just as a wheel is not a bearing, neither is a gear a bearing. Moreover, if the examiner’s argument were to be adopted, then Tadokoro’s guide 8 and wheel 33 (which do provide Tadokoro’s guidance function) would be entirely superfluous. That is, if Tadokoro’s rack and pinion drive system really provided a guidance function (according to the examiner a gear is a bearing), there would be no need for Tadokoro to provide a guide 8 and wheel 33. The correct interpretation (i.e., the one that does not render superfluous Tadokoro’s guide 8 and wheel 33) is that Tadokoro’s rack and pinion drive system does not provide a guidance function. Because Tadokoro does not meet the limitations of claim 6, Tadokoro cannot anticipate claim 6.

Last, in arguing for the propriety of his rejection of claim 12 the examiner states that “appellants did not claim require [sic] direct attachment of the worm and worm gear.” That is not the case. Claim 12 specifically requires “a motor. . . a worm attached to the shaft of the motor and a worm gear operatively connected to said first and second drive pinions. . .” Thus, in making his rejection the examiner ignores a specific limitation of claim 12. In addition, the examiner’s argument is also based on the erroneous

conclusion that Tadokoro discloses a worm and worm gear drive arrangement. Tadokoro does not. Instead, Tadokoro discloses a motor 34 that drives the pinions 41 via sprockets 35, 37 and a drive belt 36. See Figure 20 of Tadokoro. Because Tadokoro's sprocket and drive belt arrangement is not a worm and worm gear, Tadokoro cannot anticipate claim 12.

The examiner argues that dependent claim 13 is not independently allowable because Tadokoro does show a "power supply arrangement wherein 'slave' units require power from a 'master' unit." Examiner's Answer at p. 7. In fact, Tadokoro does not show that at all. First, it is not clear that Tadokoro reference number 3 is in fact a power supply. It is more frequently described by Tadokoro as a "control box." Second, Tadokoro does not disclose a master slave configuration; he discusses a plurality of different types of consoles, but not master-slave units. Finally, to the extent reference number 3 in Tadokoro is even considered a power supply, Figure 1 itself teaches away from a master-slave arrangement as claimed in claim 13. Claim 13 at issue here requires one power supply; Figure 1 of Tadokoro discloses two – one for console A and one for console D.

The examiner issued a provisional double patenting rejection based on the co-pending parent application No. 09/337,802, an application also on appeal and on which the Board issued a decision on July 24, 2003. In their Appeal Brief in this case the appellants noted that the examiner's provisional double patenting rejection was not ripe in that it was not known when and how many of the claims from the '802 application would be allowed. From the time the appellants filed their Appeal Brief in this case the status of the claims from the '802 application has changed. In the Board's decision for

the '802 application (issued July 24, 2003), the Board issued its decision affirming the examiner's rejection of claims 1, 13-15, and 24; and reversing the examiner's rejection of claims 3-7, 12 and 16-19. As those claims placed in condition for allowance are narrow claims, they cannot form the basis for an obviousness-type double patenting rejection of the broader claims at issue here. Moreover, in light of the Board's decision, it would not make sense to base a double patenting rejection on the claims that were rejected as affirmed by the Board.

CONCLUSION

Tadokoro fails to disclose the elements and limitations that are specifically set forth in the currently-pending claims. Therefore, Tadokoro cannot be used to establish the required prima-facie case of anticipation under Section 102. Accordingly, appellants request the Board to reverse the rejections of claims 1, 3-7, 12-19, and 24.

Respectfully submitted,

DAHL & OSTERLOTH, L.L.P.

By: 

Bruce E. Dahl

Registration No. 33,670

555 Seventeenth Street, Suite 3405

Denver, CO 80202-3937

(303) 291-3200

Date: 9-2-03